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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,170	04/28/2000	Mark D. Levitt	103-1345.00	3695

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EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 10/23/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,170

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicants election of Group II, claims 20-27, with traverse in Paper 9 is acknowledged. Applicants traverse the restriction requirement and submit that all the remaining claims involve floor finishes and could be examined in a single application. However, the Examiner disagrees. Groups I, III, IV, and V are directed to a coated substrate, a strip agent composition, a method for applying a finish to a substrate and a method of etching a substrate, respectively, and because these inventions are distinct for the reasons given in the Restriction Requirement mailed on September 23, 2002 (Paper No. 8) and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Hence, this restriction requirement is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is dependent on claim 20 and recites a stripability rating for the intermediate coating and the topcoat and further recites that the stripability of the topcoat corresponds "to no more than severe chemical attack on the topcoat and the

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onset of stripping, using a test strip agent made using... and a 10 minute standing time".

It is unclear, from claim 27 and the Specification, whether the strip agent composition given in claim 27 is the composition used to determine the stripability or is the composition contained in the strippable laminate finish kit. Appropriate amendment or clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20 and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

Hamrock et al. disclose a floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) comprising a radiation curable composition and a primer composition (***corresponding to the intermediate coating of the claimed invention***) wherein the primer composition is coatable over a substrate and the radiation curable composition (***corresponding to the topcoat of the claimed invention***) is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (***thus meeting the limitations that the topcoat composition comprises an***

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acrylated urethane or an aromatic urethane). The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3). All limitations of the claimed invention are disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negated by the manner in which the invention was made.

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Lake (US 5,571,570).

Hamrock et al. disclose a floor finishing system (**corresponding to the strippable laminate finish kit of the claimed invention**) comprising a radiation curable composition and a primer composition (**corresponding to the intermediate coating of the claimed invention**) wherein the primer composition is coatable over a substrate and the radiation curable composition (**corresponding to the topcoat of the claimed invention**) is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (**thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane**). The cured, coatable composition is

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readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3).

Hamrock et al. do not teach that the topcoat composition is an aliphatic polyester urethane.

However, Lake discloses a UV curable topcoat composition that exhibits superior flexibility, durability, thermal stability, crack resistance, chemical resistance, stain resistance and weather resistance and comprises a blend of an acrylated aliphatic polyester urethane (Column 2, lines 28-38 and Claim 9).

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the topcoat composition disclosed by Hamrock et al. with the composition disclosed by Lake given that Lake teach that their composition exhibits superior flexibility, durability, thermal stability, crack resistance, chemical resistance, stain resistance and weather resistance.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Koreltz et al. (WO 94/22965).

Hamrock et al. disclose a floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) comprising a radiation curable composition and a primer composition (***corresponding to the intermediate coating of the claimed invention***) wherein the primer composition is coatable over a substrate and the radiation curable composition (***corresponding to the topcoat of the claimed invention***) is coatable thereon (Page 6, lines 25-30). The radiation curable

coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group **(thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane)**. The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3).

Hamrock et al. do not teach that the floor finishing system **(corresponding to the strippable laminate finish kit of the claimed invention)** further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Hamrock et al. given that such compositions can be used to remove multiple coating comprising urethane/acrylic polymers.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-

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0594. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.



Sheeba Ahmed
October 20, 2002



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700